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IN THE UNITED STATES DISTRICT COURT  
IN AND FOR THE SOUTHERN DISTRICT OF CALIFORNIA  
SAN DIEGO DIVISION

ISIS PHARMACEUTICALS, INC., a  
Delaware Corporation,

Plaintiff,

v.

SANTARIS PHARMA A/S CORP., a  
Delaware corporation, and SANTARIS  
PHARMA A/S, a Danish Corporation,

Defendants.

AND RELATED COUNTERCLAIMS.

NO. 11-CV-2214 GPC (KSC)

**SUPPLEMENTAL JOINT MOTION FOR  
RESOLUTION OF DISPUTE WITH  
RESPECT TO DR. NICHOLAS M.  
DEAN'S ACCESS TO DOCUMENTS  
DESIGNATED BY SANTARIS AS  
"CONFIDENTIAL INFORMATION"  
UNDER PROTECTIVE ORDER FILED  
UNDER COURT'S ORDER OF MAY 17,  
2013 [DKT 140]**

***PUBLIC VERSION***

Pursuant to this Court's Order of May 17, 2013 [Dkt. No. 140], Plaintiff Isis Pharmaceuticals, Inc. ("Isis") and Defendants Santaris Pharma A/S and Santaris Pharma A/S Corp. (collectively, "Santaris") hereby respectfully submit this supplemental joint motion seeking a resolution of their dispute with respect to whether Dr. Nicholas Dean, an expert witness proposed by Isis, can be afforded access to documents and information designated by Santaris as "Confidential Information." The parties request that the Court take judicial notice of the initial Sealed Joint Motion For Resolution of Dispute With Respect to Expert Access to Documents Designated by Santaris as "Confidential Information" Under Protective Order filed at Dkt. No. 115, as well as all declarations and exhibits accompanying that Joint Motion at Dkt. Nos. 113 and 115.

## **I. INTRODUCTIONS**

### **A. ISIS**

Dr. Dean in good faith on May 22 provided the disclosures on his consulting as required by the Court in its May 17 Order following the March 4 Joint Motion. All of the information confirms Dr. Dean's independence to serve as an expert for Isis in this matter under the Ninth Circuit's *Brown Bag* decision and the relevant district court cases both parties cited to the Court in the first round of briefing. The essential facts are not in dispute.

- Dr. Dean has not worked for Isis for seven years, owns no Isis stock, has no professional relationship with Isis nor a personal relationship other than to socialize occasionally with Isis's Frank Bennett.
- [REDACTED]
- Dr. Dean has agreed to the additional protections for Santaris that if he should come across confidential information on a target that somehow is implicated in his other consultancies, he will immediately cease all work on that target and will not read information on it beyond that — a protection not

1 required under the Protective Order or under the law but offered by Dr. Dean  
 2 to further reduce any risk of disclosure. [REDACTED]

- 3 [REDACTED]  
 4 [REDACTED]
- 5 • Santaris now disavows its earlier reliance on the Ninth Circuit's *Brown Bag*  
 6 decision, effectively arguing that it's balancing requirements have been  
 7 trumped by this Court's *sua sponte* May 17 Order that the parties should  
 8 include Paragraph 8 of the standard Southern District of California model  
 9 protective order provision on disclosing consultancies, and incorporate its  
 10 definition of independence. But Isis has never understood that Order to be in  
 11 conflict with binding Ninth Circuit law, but instead to be interpreted in a way  
 12 that requires a balancing of the risk of inadvertent disclosure against need of  
 13 the other party to disclose the information. *Brown Bag*, as interpreted by the  
 14 *Santella* District Court, requires that Dr. Dean be a competitive decision  
 15 maker. Those cases do not hold that he is automatically disqualified by the  
 16 mere fact that he consults for a competitor (which is incorrect). Santaris is  
 17 using overly broad definitions of competition and reading the Amended  
 18 Protective Order divorced from Ninth Circuit law to prevent Isis from using  
 19 an industry expert to address Santaris's acts of infringement.

- 20 • Meanwhile, Santaris has no qualms about disclosing its confidential  
 21 information to industry competitors to serve as its experts when it suits  
 22 Santaris's purposes. Santaris argues that the issue is inadvertent disclosure  
 23 and that it is acting "reasonably" under the Amended Protective Order. [REDACTED]

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○ [REDACTED]

[REDACTED]

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■ [REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

- Further, Santaris's claims of competition are stretched. [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]

1 will not share documents with Dr. Dean that involve the [REDACTED]  
 2 employed by those clients, if any exist.<sup>1</sup>

- 3 • Santaris concedes that Dr. Dean will abide by the Protective Order and will  
 4 not knowingly violate its provisions. *See Presidio Components v. American*  
 5 *Technical Ceramics* cited in the Court's May 17 Order (finding protective  
 6 order prohibited express disclosure and provided a suitable remedy.) One of  
 7 those provisions, a Prosecution Bar, prohibits Dr. Dean from actively  
 8 prosecuting on disclosed subject matter (rendering moot the issue of any  
 9 pending legacy patent applications and the assigned applications he filed  
 10 when at Excaliard).
- 11 • The prejudice to Isis is great. (i) It is difficult to locate individuals steeped in  
 12 the field of antisense drug discovery at issue in this case because such work  
 13 is performed by companies, as Santaris's own choice of experts show: Not  
 14 one is an academic. (ii) Isis has already made significant investments in Dr.  
 15 Dean's consultancy in this case while having to meet and defeat Santaris's  
 16 premature summary judgment motion. (iii) Barring Dr. Dean confidential  
 17 access provides Santaris with an unfair advantage: Santaris can select  
 18 industry experts from competitors ([REDACTED]) to whom it will disclose  
 19 its confidential information and from whom it will proffer expert testimony,  
 20 yet prohibit Isis from presenting expert testimony from its industry experts to  
 21 Judge and Jury. Santaris should not be permitted to so use the shield of the  
 22 Amended Protective Order as a weapon.

23  
 24 <sup>1</sup> Santaris faults Dr. Dean heavily for not permitting its counsel to disclose to  
 25 Santaris the name of the companies Dr. Dean disclosed. But the information does  
 26 not belong to Dr. Dean: *It belongs to his clients*. His conduct further confirms the  
 27 high regard he holds his receipt of anyone's confidential information. Moreover, at  
 28 the May 6 hearing, this Court stated to Santaris's counsel that it would have to have  
 a "pretty darn good reason" for the information to be disclosed to Santaris. Given  
 Santaris and its counsel's sweeping view of competition and the Amended  
 Protective Order, it has never advanced that pretty darn good reason and in view of  
 its failures to do so, its arguments faulting Dr. Dean have no basis.

1 Isis met and conferred with Santaris on May 30, and sent a draft Joint Motion  
 2 the next day asking to file this Motion on shortened time. Santaris's counsel failed  
 3 at that time to identify any specifics articulated in this motion. Knowing that Isis  
 4 needs Dr. Dean to oppose Santaris's renewed Motion for Summary Judgment to be  
 5 filed on June 24, on the evening of June 6 Santaris — for the first time — raised a  
 6 number of supposed specifics to buttress its objection to Dr. Dean being approved  
 7 under the Protective Order. Santaris's delay, and its lack of transparency,  
 8 ultimately cannot conceal the lack of merit to its positions. Time is short, as  
 9 Santaris will file its motion for summary judgment on June 24. Isis respectfully  
 10 asks for expedited consideration of this motion.

#### 11 **B. SANTARIS**

12 There are two grounds under the Amended Protective Order to deny Isis's  
 13 motion to overrule Santaris's objection to Dr. Dean seeing Santaris's most  
 14 confidential scientific and business information. First, Dr. Nicholas Dean is not an  
 15 "Independent Expert," as that term is defined in the Amended Protective Order.  
 16 Instead, he actively consults for companies that are *competitors* of Santaris. Dr.  
 17 Dean began two of those competitive consulting arrangements in 2013 at the same  
 18 time he was seeking access to Santaris's most confidential information, fully  
 19 understanding the risk that those new arrangements may disqualify him from seeing  
 20 Santaris's attorney's eyes only information. Second, Santaris's objection to Dr.  
 21 Dean's seeing its most secret and valuable information is reasonable, and the  
 22 Amended Protective Order provides the parties with that reasonable discretion. The  
 23 scope of Dr. Dean's active consulting business, his longstanding ties with Isis, and  
 24 the likelihood that Dr. Dean will consult in the future for other directly competitive  
 25 clients all confirm that Santaris's objection is, at a minimum, reasonable. Isis  
 26 recognized that each party is permitted to exercise reasonable discretion under the  
 27 Protective Order when it objected to [REDACTED], Santaris's expert, preventing  
 28 [REDACTED] from seeing highly confidential information produced by Isis.

1 [REDACTED]  
2 [REDACTED] Contrary to Isis's new and artificial  
3 view of competition, siRNA and RNAi are antisense technologies that compete  
4 with the technology of Santaris. Isis's May 22, 2013 letter impliedly admits that  
5 fact [REDACTED]

6 [REDACTED] Declaration of Ashley E. Johnson ("Johnson Decl.") Exh. A.

7 [REDACTED]  
8 [REDACTED] This is precisely what Santaris does.  
9 Most, like Santaris, are competing for contracts with pharmaceutical companies to  
10 develop drug candidates. The competition is clear to Santaris's counsel, even  
11 though it has been denied the opportunity to discuss even the names of the entities  
12 with Santaris because Dr. Dean refuses to allow such minimal disclosure to  
13 Santaris. [REDACTED]

14 [REDACTED] Those provisions, however, have never  
15 been shared with Santaris or this Court, and the claimed strictness of those  
16 provisions is belied by the fact that some of the engagements have been publicly  
17 disclosed by his own clients. And while Dr. Dean has to date never quoted from  
18 those agreements, [REDACTED]

19 [REDACTED] That  
20 suggestion, as discussed below, is definitively wrong as to two of his clients, and  
21 likely exaggerated as to the others—but regardless, counsel has not been given the  
22 information that it would need to test the remaining assertions.



1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED]  
9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED]

13 Even beyond Dr. Dean's current engagements with Santaris's competitors,  
14 and his overzealous assertions about their confidentiality, Santaris has numerous  
15 reasons to reasonably object to disclosure of its most sensitive confidential  
16 information to Dr. Dean. Despite previously declaring that he did not have a  
17 "direct business or social relationship with Isis" [Dkt. 113-17], Isis now admits that  
18 Dr. Dean has a social relationship with Dr. Frank Bennett, the Senior Vice  
19 President of Research at Isis, who is responsible for antisense drug discovery and  
20 antisense technology research at Isis, and with whom Dr. Dean has collaborated on  
21 18 antisense patents. Johnson Decl. Exhs. C & D. Indeed, that relationship is  
22 beyond social—since his departure from Isis, Dr. Dean and Dr. Bennett have  
23 applied for at least four antisense patents, assigning two of them to be jointly  
24 owned by Isis and Excaliard and reserving two others for themselves. Johnson  
25 Decl. Exhs. E & F.

26 Also, Dr. Dean worked for Isis for 15 years and collaborated with Isis for  
27 another six in a related company (Excaliard) that Isis and its principals created. It  
28 was only after this litigation was commenced that Dr. Dean and Isis sold their

interests in Excaliard to Pfizer (with whom Santaris has a collaboration agreement at issue in this case) for millions of dollars, an arrangement that very likely will continue to benefit Dr. Dean and Isis through earn out payments or in other ways. Based on these and other facts, it is not unreasonable for Santaris to withhold its approval of Dr. Dean to view Santaris's most highly confidential information.

Isis's claimed prejudice is greatly exaggerated. Santaris's objection does not block Isis from using Dr. Dean as an expert. It only blocks Isis from sharing with him Santaris's attorney's eyes only information that Isis's other two experts—Drs. Gordon and Gellman—are permitted to review. Isis's other straw man prejudice argument is also wrong—Santaris is not signaling that it will object to every expert who consults for a competitor. Instead, Santaris will judge each proposed expert on the facts presented and will exercise its judgment reasonably. If Isis truly needs yet a third expert to view Santaris's highly confidential information, there are many potential experts available to assist it who would not draw an objection from Santaris. If Isis has suffered any prejudice at all, Isis should discuss that claim with Dr. Dean, who in 2013 accepted as clients two competitors of Santaris as his personal clients, thus confirming yet further that he is not an independent expert.<sup>3</sup>

## II. ISIS ARGUMENT

### A. DR. DEAN IS INDEPENDENT UNDER THE NINTH CIRCUIT'S *BROWN BAG* DECISION AND DISTRICT COURT AUTHORITY ON INDEPENDENCE OF EXPERTS

#### 1. Dr. Dean is Independent of Isis

As Santaris acknowledges (*infra*, 26:9-12, 30:12-20), the issue is inadvertence and whether there is an unacceptable risk of disclosure, drawing on

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<sup>3</sup> Isis's claim of lack of transparency by Santaris's counsel in meet and confer exchanges is not only factually incorrect, it does not assist the Court in resolving the substance of the dispute between Isis and Santaris. It is sufficient to say that if Dr. Dean had allowed counsel to confer with Santaris about the names of the companies that Dr. Dean consults for, counsel's investigation would have been easier and gone more quickly. If the Court, however, wants counsel to respond in more detail, counsel can do so quickly.

1 the Ninth Circuit decision in *Brown Bag Software v. Symantec Corp.*, 960 F.2d  
 2 1465 (9th Cir. 1992). There the Court held that a proffered in-house counsel must  
 3 be a competitive decision maker for confidential access to be denied. *Id.* at 1470.  
 4 The “party opposing disclosure has the burden of establishing that there is good  
 5 cause to continue the protection of the discovery material.” *Santella v. Grizzly*  
 6 *Industries, Inc.*, No. 3:12-mc-00131-SI, 2012 U.S. Dist. LEXIS 158349, at \*4 (D.  
 7 Or. Nov. 5, 2012) (internal quotations omitted) (applying *Brown Bag* in the expert  
 8 context). Certainly, the Court’s Amended Protective Order harmonizes with the  
 9 controlling Ninth Circuit balancing of standard enunciated in *Brown Bag*. It does  
 10 not, as Santaris asserts, counter it<sup>4</sup> by setting a standard that effectively any  
 11 consultant who arguably works for a competitor is disqualified. (*Infra*, 32:2-8.)

12 There is no question here that Dr. Dean is independent of Isis. He has not  
 13 worked at Isis for seven years, owns no stock in Isis, has no professional  
 14 relationship with Isis, is not a competitive decision maker of Isis, and only  
 15 occasionally socializes with a former colleague at Isis. (Gaede Decl., ¶ 24, Ex. 16,  
 16 ¶ 8; *id.* ¶ 33, Ex. 24, ¶¶ 2-3.) [REDACTED]

17 [REDACTED]  
 18 [REDACTED] While Santaris argued that it reasonably believed that  
 19 Dr. Dean was too closely associated with Isis in the original Joint Motion, the facts  
 20 then and additional facts provided do not in any way support that conclusion.  
 21 Santaris points to patent applications filed contemporaneous with Dr. Dean’s tenure  
 22 at Excaliard (*infra*, 33:3-10), but Excaliard no longer exists; the applications were  
 23 assigned; and Dr. Dean is subject to the Protective Order’s Prosecution Bar,

24 \_\_\_\_\_  
 25 <sup>4</sup> The Court should note Santaris’s shifting view on which precedent controls. In  
 26 the opening Joint Motion and at its appearance before the Court on May 6, Santaris  
 27 relied heavily on *Beam Sys., Inc. v. Checkpoint Sys., Inc.*, 1997 WL 364081 (C.D.  
 28 Cal. Feb. 6, 1997). See Discovery Hearing Transcript (“Disc. Hr. Tr.”) 30:2-16,  
 May 6, 2013(Santaris Counsel: “The Beam case supports us”). Santaris now  
 expressly disavows that authority. (*Infra*, 32:2-8.) Santaris also faults Dr. Dean for  
 disclosing that he occasionally socializes with Dr. Bennett as if that constitutes  
 directly socializing with Isis.

1 providing ample protection to Santaris. (Gaede Decl., ¶ 24, Ex. 16, p 3; *id.* ¶ 33,  
2 Ex. 24, ¶ 6.)

3 Moreover, Santaris agrees that the *Brown Bag* analysis weighs any risks of  
4 inadvertent disclosure against the safeguards imposed to guard against it. 960 F.2d  
5 at 1470; *see* 26:26-27:2, *infra*. Here, Isis and Dr. Dean have voluntarily agreed to  
6 limit disclosures to Dr. Dean in order to address concerns raised by Santaris in this  
7 and prior briefing. *First*, Dr. Dean will immediately cease reviewing Santaris  
8 confidential documents if, during the preparation of his opinions in this case, he  
9 comes across information about a gene target that one of his current clients is also  
10 pursuing. (Gaede Decl., ¶ 24, Ex. 16, ¶ 20.) *Second*, [REDACTED]  
11 [REDACTED]  
12 [REDACTED]

13 *Third*, Dr. Dean will treat confidential Santaris  
14 information with the same due care and regard reserved for the confidential  
15 information of his own clients. (Gaede Decl., ¶ 24, Ex. 16, ¶¶ 12-13.) Indeed, that  
16 he has scrupulously observed his obligations to his current clients by refusing to  
17 permit Santaris counsel from sharing his recent disclosures with top Santaris  
18 executives shows, contrary to Santaris's assertions (*infra*, 30:16-22), the very  
19 judgment he will employ to protect Santaris information.

20 **2. Dr. Dean's Consultancies Do Not Compete With Santaris  
21 Nor Involve Competitive Decision Making as Required  
22 Under *Brown Bag***

23 Santaris now argues that Dr. Dean currently helps its competitors "monetize"  
24 RNA drug discovery just like Santaris is trying to do, and so Dr. Dean cannot be  
25 trusted to maintain the confidentiality of sensitive Santaris information. But  
26 Santaris applies the wrong standard. The issue before the Court is not competition  
27  
28

1 in the abstract but is, as Santaris has stated, one of whether there is an unacceptable  
2 risk of inadvertent disclosure.<sup>5</sup>

3 In that regard the cases are clear: Even if Dr. Dean's consulting clients were  
4 true "competitors" of Santaris (a point Isis disputes), "[a] competitive relationship  
5 alone, however, is not sufficient to find that [a proposed expert] will inadvertently  
6 disclose [the producing party's] confidential information." *Santella*, 2012 U.S.  
7 Dist. LEXIS at \*16 (applying *Brown Bag*); *Brown Bag*, 960 F.2d at 1470. The  
8 proposed expert must also "be in a position to effectuate or direct decisions made  
9 using knowledge that is tainted by . . . confidential information." *Santella*, 2012  
10 U.S. Dist. LEXIS at \*16-17. In other words, Dr. Dean must act as a competitive  
11 decision-maker for the Court to deny him access to Santaris confidential  
12 information. He does not, and Santaris asserts no compelling reason to find  
13 otherwise.

14 In response to the Court's May 17 Order [Dkt. No. 140], [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]

23  
24 <sup>5</sup> See Joint Motion [Dkt. No. 115] at 39:28-40:3 ("But Santaris's concern is not that  
25 Dr. Dean will *intentionally* violate his obligations. Its concern is that disclosure of  
26 Santaris's confidential information to Dr. Dean presents a common sense risk of  
27 inadvertent disclosure or misuse.")  
28 <sup>6</sup> [REDACTED]

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[REDACTED]  
[REDACTED] Santaris's argument fails on  
this critical second prong of the *Brown Bag* analysis.

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

Specifically:

- [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
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Santaris's in-house and trial counsel take a broad, subjective view of competition. They assert that companies in Santaris's competitive space include those using many different technologies, such as siRNA, RNAi, and

<sup>7</sup>

"The LNA Drug Platform and Drug Discovery Engine developed by Santaris Pharma A/S combines the Company's proprietary LNA chemistry . . . to rapidly deliver potent single-stranded LNA-based drug candidates for a range of diseases including *metabolic disorders, infectious and inflammatory diseases, cancer and rare genetic disorders.*" (Gaede Decl., ¶ 14, Ex. 8.)

oligonucleotides that are not at issue in this case.<sup>9</sup> (*Infra*, 23:15-24:4, 35:3-20.) Effectively, Santaris wrongly contends that any expert currently working in the broad field of “RNA therapeutics” is inappropriate to serve as an expert in a legal proceeding if that expert requires access to the defendant’s confidential information. That result hobbles patent holders before Judge and Jury where the defendant can present such an expert, but the patent holder may not.

### 3.

#### to be Unreasonable

The unreasonableness of Santaris’s objection to Dr. Dean shows in its choice of [REDACTED] as one of two experts with whom Santaris proposes to share Isis confidential information.<sup>10</sup> [REDACTED]

<sup>9</sup> Santaris makes much of an Isis webpage explaining different “Antisense Approaches — Mechanisms and Targets.” (*Infra*, 22:10-15; see Gaede Decl., ¶ 15, Ex. 9.) However, the issue is not how many different molecular mechanisms of gene inhibition Isis categorizes under the “antisense” descriptor. The issue is the scope of information reasonably likely to be shared with Dr. Dean during this case. That information is limited by the claims and defenses in-suit to gapped oligonucleotides of the kind claimed in Isis’s asserted patents, as well as microRNAs employed by Santaris during performance of some of the accused contracts. Neither type of molecule are “RNAi” or “siRNA.”

<sup>10</sup> Best Email to Isis Counsel dated March 12, 2013 ([REDACTED] under the Protective Order), Gaede Decl., ¶ 16, Ex. 10; Dis [REDACTED] antaris Counsel Fred Brown at the May 6 hearing: “It’s most likely we are only going to use Dr. Brown and Dr. [Ohlstein].”)



[illegible]

Santaris has engaged and provided its confidential information to its expert, [REDACTED], who does not qualify under *Brown Bag / Santella, Symantec (infra)*, nor the Amended Protective Order. Its act of turning a blind eye to the inadvertence risk this poses when it suits its litigation purpose highlights the unreasonable and tactical nature of its objection. Neither *Brown Bag / Santella* nor the Amended Protective Order countenance this unbalanced result.

**B. THE PREJUDICE TO ISIS IS MATERIAL**

As discussed at the May 6 hearing, material prejudice will befall Isis if Dr. Dean cannot opine on scientific evidence presented in Santaris confidential documents. [REDACTED]

[REDACTED] This is particularly so given that only two drug products have been approved by the FDA during the more than 20 year history of the antisense industry.

[REDACTED] (*Id.*, ¶ 20, Ex. 13.) Dr. Dean would provide the Court with another view drawn from his 30 years of drug discovery and development experience. (*Id.* at ¶ 24, Ex. 16, ¶¶ 8, 10.)

Where certain Santaris activities fall on the continuum between drug discovery and drug development will amount to a key issue in the Court’s resolution of whether Santaris may claim absolute exemption from infringement under Section 271(e)(1). *See* Dkt No. 53 at 6:23-24 (Judge Moskowitz finds that “[t]he Safe Harbor does not apply, however, where a biological compound is used to perform ‘basic scientific research’ or as a ‘research tool’”). The loss of Dr. Dean would leave Isis without an antisense industry expert<sup>11</sup> permitted access to Santaris drug discovery documents needed to address this point. The claims and issues in dispute require an expert with antisense industry experience, and yet no expert can satisfy Santaris’s sweeping definition of a “competitor” because any viable expert will consult for or have some tie to companies in the industry — even academics — as that is the very essence of an “industry expert” in a case where industry drug discovery is at issue.

<sup>11</sup> Isis’s two other experts cleared under the Protective Order — Dr. Elizabeth Gordon (FDA regulation) and Dr. Claire Gelfman (basic ophthalmology) — have altogether different expertise than Dr. Dean and play a different role for Isis.

1 Finally, Isis has invested substantially in Dr. Dean, including by his drafting  
 2 and submitting a 25 page declaration in opposition to Santaris's early and flawed  
 3 summary judgment motion. (Gaede Decl., ¶ 25.) Santaris argues that Isis has long  
 4 had notice of Santaris's objection to Dr. Dean and assumed any risk (*infra*, 33:14-  
 5 34:21). But the simple fact is that Isis invested in Dr. Dean well before Santaris's  
 6 first objection to him in November 2012 when it opposed Santaris's ill-conceived  
 7 early summary judgment motion filed January 30, 2012. Having caused this  
 8 investment prejudice, Santaris should not now be heard to minimize it.

9 Santaris's prior assertion that a search on Westlaw for antisense or  
 10 oligonucleotide yields over 500 "results" is highly misleading. (*See* 33:19-28,  
 11 *infra*.) A high proportion of those results are simply duplicate references to the  
 12 same purported experts, with numerous experts listed multiple times, including  
 13 many that are listed 10 or more times. Of the actual unique experts contained  
 14 within that list, the overwhelming majority appear to have been included by virtue  
 15 of their publication of just one or two passing articles regarding a single experiment  
 16 or series of experiments utilizing antisense oligonucleotides. Many of those articles  
 17 are extremely dated, and thus do not reflect current expertise necessary to evaluate  
 18 Santaris's Safe Harbor affirmative defense that depends highly on the capabilities  
 19 of the field as of today. The remainder either lacked sufficient practical experience  
 20 or appear to have relationships with "competitors" that would be deemed  
 21 disqualifying under the standards urged by Santaris.

### 22 C. SANTARIS RELIES ON QUESTIONABLE AUTHORITY

23 Attempting to lead the Court to error, Santaris relies on *Symantec Corp. v.*  
 24 *Acronis Corp.*, No. 11-5310 EMC (JSC), 2012 WL 3582974 (Aug. 20, 2012 N.D.  
 25 Cal.). The court there denied confidential access to a proposed expert who actively  
 26 consulted with competitors of the producing party. *Id.* at \*3. The decision,  
 27 however, did not apply the Ninth Circuit's balancing approach set out in *Brown*  
 28

1 *Bag*, but instead applied a far more stringent standard requiring that the proffered  
2 expert “possess unique expertise” before permitting him confidential access. *Id.*

3 This Court should decline to follow the nonbinding *Symantec* decision. First,  
4 the facts there limit its reach to “the very specific situation presented by” its  
5 proposed expert, namely, someone who actively consults with true competitors of  
6 the producing party. *Id.* at \*12. Such is not the case with Dr. Dean. (*See* 12:5-  
7 13:17, *supra.*) Moreover, the *Symantec* court found that the proffered expert lacked  
8 unique expertise. 2012 WL 3582974 at \*11. Yet Dr. Dean possesses uncommon  
9 knowledge of an antisense industry with which few individuals have actual  
10 discovery and development experience. (*See* 16:2-13, 17:9-21, *supra.*)

11 Second, *Symantec* relies upon authority holding that an expert without an on-  
12 going relationship with a competitor may access confidential information. *Verigy*  
13 *US, Inc. v. Mayder*, No. C07-04330 RMW (HRL), 2008 U.S. Dist. LEXIS 111116,  
14 at \*3-4 (Sept. 8, 2008); *Advanced Semiconductor Materials Am., Inc. v. Applied*  
15 *Materials, Inc.*, No. C-95-20169 RMW (EAI), 1996 U.S. Dist. LEXIS 21459, at  
16 \*10 (Oct. 28, 1996). Each court noted that the sanctioned expert had signed the  
17 governing Protective Order (*ibid.*), and in *Advanced Semiconductor* the producing  
18 party “must look to the Protective Order and to the laws of theft of trade secrets for  
19 its protection.” *Id.* at \*10-11. The same is true here.

20 Finally, *Symantec* was wrongly decided. By its analysis, the very credentials  
21 that qualify someone as an expert in the patented subject matter (*Symantec*, 2012  
22 WL 3582974 at \*2) become “on-going relationships with competitors in the field”  
23 of the producing party. *Id.* at \*3. Those relationships are then disqualifying unless  
24 the expert has “unique expertise.” If a field has even two suitable experts, then  
25 parties will be *per se* unable to use their chosen expert. Surely that cannot be the  
26 law, and is contrary to *Brown Bag*’s balancing requirement. Moreover, with all due  
27 respect to the *Symantec* Court, the decision appears unreliable as it states that it  
28

1 could find no case within the Ninth Circuit on the issue. *Id.* at \*11 n.1. *Symantec*  
 2 plainly did not consider *Brown Bag* nor *Santella*.

### 3 **III. SANTARIS ARGUMENT**

4 Although the disclosure of information designated “Confidential – For  
 5 Outside Counsel Only” is explicitly governed by Paragraph 8 of the parties’  
 6 Protective Order, Isis does not so much as quote that language in meet and confer  
 7 communications or in the draft of its motion, instead relying exclusively on its  
 8 mistaken understanding of case law. Paragraph 8 does not mention “competitive  
 9 decision maker[s],” or permit disclosure to any expert who agrees not to  
 10 “knowingly violate its provisions.” *Jt. Mot.* at 4. Nor does Paragraph 8 provide  
 11 that disclosure of highly confidential material will be governed by *Brown Bag*  
 12 *Software v. Symantec Corp.*, 960 F.2d 1465 (9th Cir. 1992). Instead, the Amended  
 13 Protective Order, which was signed 20 years after *Brown Bag* was decided and  
 14 adopts a different standard, expressly provides two limitations on permissible  
 15 disclosures to experts. *First*, she must be an “Independent Expert,” defined in the  
 16 Order as one who “is not anticipated to become an employee of, or a non-litigation  
 17 consultant of a party or competitor of a party.” Amended Protective Order, ¶ 8.<sup>12</sup>  
 18 *Second*, even if she is an “Independent Expert,” the disclosing party may still  
 19 withhold approval so long as approval is not “unreasonably withheld.” *Id.*<sup>13</sup> Dr.  
 20 Dean is not an “Independent Expert,” and Santaris’s decision to withhold its  
 21 approval is not unreasonable. Accordingly, Isis’s request should be denied on  
 22 either or both grounds.

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 25  
 26 <sup>12</sup> The definition of “Independent Expert” was adopted verbatim from the Court’s  
 27 Model Protective Order, ¶ 5.

28 <sup>13</sup> The approval condition was adopted verbatim from the Court’s Model Protective  
 Order, ¶ 12.

1           **A. DR. DEAN IS NOT AN “INDEPENDENT EXPERT” UNDER PARAGRAPH**  
 2           **EIGHT OF THE AMENDED PROTECTIVE ORDER**

3           Under the Amended Protective Order, the term “Independent Expert” is  
 4 defined as “a person with specialized knowledge or experience in a matter pertinent  
 5 to the case who has been retained by Counsel to serve as an expert witness or as a  
 6 litigation consultant in this case, and who is not a current employee of a party or of  
 7 a competitor of a party and who, at the time of retention, is not anticipated to  
 8 become an employee of, or a non-litigation consultant of a party or competitor of a  
 9 party.” Dr. Dean is not an Independent Expert, because he is a non-litigation  
 10 consultant for Santaris’s competitors. Because Confidential Information may *only*  
 11 be disclosed to Independent Experts, he is thus ineligible to receive disclosures of  
 12 such information under the Order.

13           After withholding for several months any meaningful information about his  
 14 consulting relationships, Dr. Dean very recently disclosed several consulting  
 15 engagements, most of which are, in counsel’s view, directly competitive with  
 16 Santaris. As an initial matter, it is critical to note that Santaris’s ability to evaluate  
 17 those engagements and address the prejudice to it in detail is hampered by Dr.  
 18 Dean’s refusal to allow counsel to share even the *names* of the competitors with  
 19 Santaris.<sup>14</sup> Yet he seeks access to the identity of the Santaris’s targets, and much  
 20 much more—though the target identity alone is extremely valuable. As Dr. Bojko  
 21 of Santaris explains, (a) the choices of which among the many thousands of  
 22 potential specific RNA molecules to target are among Santaris’s most closely  
 23 guarded trade and scientific secrets; (b) disclosing merely the identity of the

24           <sup>14</sup> In an effort to minimize the scope of disclosure, Santaris repeatedly made clear  
 25 that it requested only to disclose the names of the entities, and also emphasized that,  
 26 if Isis would be more comfortable with disclosure to fewer or different people at  
 27 Santaris, Santaris was open to considering Isis’s proposal on that issue. Johnson  
 28 Decl. Exhs. G & H. Isis made no such proposal, instead categorically refusing to  
 permit Santaris to have client input on the disclosure of its most confidential  
 information to an expert who actively consults with its competitors.

1 targets—even without any disclosing any other technical details—conveys valuable  
 2 and competitive information about Santaris's commercial and therapeutic strategy;  
 3 (c) this information informs competitors of the most worthwhile ventures, but also  
 4 informs them of the ventures perhaps not worth pursuing; and (d) even where a  
 5 target may be disclosed in the later stages of development, there is still much  
 6 information that is enormously valuable that is not disclosed, for example such as  
 7 the potential binding sites on any individual target RNA molecule for which one  
 8 may design an antisense oligonucleotide to bind, or the methods and assays used to  
 9 design an optimal antisense oligonucleotide. It is ironic that Dr. Dean is unwilling  
 10 to disclose just seven names to Santaris, yet Isis deems it unreasonable for Santaris  
 11 to object to Dr. Dean having unfettered access to a veritable mountain of Santaris's  
 12 most confidential information, including its laboratory notebooks, joint planning  
 13 documents, documents disclosing its proprietary scientific know how and trade  
 14 secrets, business plans, scientific plans, targets, and forecasts, and many other  
 15 categories of documents.

16 In any event, it would be unusual for all [REDACTED] consulting engagements to be  
 17 as restrictive as Dr. Dean suggests and to bar even the name of the client from being  
 18 disclosed. And in fact, it appears that the confidentiality demands of these  
 19 engagements have been exaggerated. [REDACTED]

20 [REDACTED]  
 21 [REDACTED]  
 22 [REDACTED]  
 23 [REDACTED]  
 24 [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
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[REDACTED]

Further, counsel's conclusion that the entities disclosed by Dr. Dean compete with Santaris is supported by at least the following:

*First,* [REDACTED]

[REDACTED] As Isis discloses on its website, antisense technology includes RNase H activation, RNAi, siRNA, microRNA and alternative splicing. Johnson Decl. Exh. K. [REDACTED]

[REDACTED]

*Second,* [REDACTED]

[REDACTED]

[REDACTED]



1 [REDACTED] [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED] [REDACTED]  
6 [REDACTED] But in order to avoid the conclusion that Dr. Dean is  
7 consulting for competing companies, Isis tries to redefine “competition” today as  
8 companies that work on the same therapeutic target. Isis’s new definition of  
9 “competition” is both artificial and inaccurate, and was far more restrictive than the  
10 definition of competition used by Isis when it opposed Santaris’s motion for  
11 summary judgment. In any case, so long as Santaris’s judgment on which  
12 companies are competitors is reasonable, the Protective Order allows Santaris to  
13 make that judgment. Here, not only is Santaris’s judgment reasonable, but the  
14 companies for which Dr. Dean consults are in fact, competitors of Santaris.

15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED] [REDACTED]  
18 [REDACTED]  
19 [REDACTED] [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED] [REDACTED]  
26 [REDACTED]  
27 [REDACTED]  
28 [REDACTED] or view itself, as having technology

1 that will produce results only in specified therapeutic areas. [REDACTED]

2 [REDACTED]

3 [REDACTED]

4 [REDACTED]

5 *Third,* [REDACTED]

6 [REDACTED]

7 [REDACTED]

8 [REDACTED]

9 *Fourth,* [REDACTED]

10 [REDACTED]

11 [REDACTED]

12 [REDACTED] [REDACTED]

13 [REDACTED] [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 [REDACTED] [REDACTED]

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 *Fifth,* [REDACTED]

26 [REDACTED]

27 [REDACTED]

28 [REDACTED] [REDACTED]

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*Sixth,*

*Seventh,*

\* \* \*

For all of these reasons, Dr. Dean is not an Independent Expert as defined in the Amended Protective Order.

**B. SANTARIS’S OBJECTION TO DISCLOSURE OF ITS MOST SENSITIVE INFORMATION TO DR. DEAN IS REASONABLE AND THUS PERMITTED UNDER THE PROTECTIVE ORDER.**

The analysis as to whether Dr. Dean is an “Independent Expert,” is not the end of the inquiry. Instead, the Protective Order specifically requires that “[t]he approval of *Independent Experts* must not be unreasonably withheld.” Para. 8 (emphasis added). The Protective Order thus unambiguously contemplates that some experts, *even though they are independent*, can be the subject of a reasonable objection. Thus, even if Dr. Dean were independent, which he is not, Santaris would still be able to object if the grounds are reasonable. As revealed in the prior

1 section, Santaris has more than a reasonable basis to object to Dr. Dean. Still there  
2 are additional grounds that show the reasonableness of Santaris's objection.

3 **1. The Case Law Recognizes Multiple Considerations That**  
4 **Weigh Against Permitting Disclosure to Dr. Dean and**  
5 **Justify Santaris's Objection**

6 Isis portrays the Ninth Circuit's *Brown Bag* decision as "requir[ing] that the  
7 individual be a competitive decision maker to warrant lack of access," and asserts  
8 that Dr. Dean is not a "competitive decision maker." Jt. Mot. at 8-11. Both  
9 arguments are wrong.

10 While one factor in considering the degree to which inadvertent disclosure is  
11 a risk is the degree to which the recipient is a "competitive decision maker," *Brown*  
12 *Bag* was clear that the inquiry is a broader one into all facts and circumstances. *See*  
13 *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1470 (9th Cir. 1992). In  
14 *Brown Bag*, the client's outside counsel withdrew late in the case and the client  
15 hired in-house counsel to appear on its behalf instead. *Id.* at 1469. The question for  
16 the Court was whether "attorneys' eyes only" material could be now shown to that  
17 in-house counsel. Far from holding that this question could be resolved on the  
18 basis of whether the in-house counsel was a "competitive decision maker," the  
19 Court concluded that the "conflicting interests" at issue in such disputes – the  
20 receiving party's right to review discoverable evidence, and the producing party's  
21 right to be protected from misuse of its documents by competitors – "suggest that a  
22 balancing test will best resolve protective order disputes such as the one here."  
23 *Brown Bag*, 960 F.2d at 1470. The court thus stated that, at least in one particular  
24 case considering disclosure to counsel, "a" – not "the" – "crucial factor . . . was  
25 whether in-house counsel was involved in 'competitive decisionmaking'; that is,  
26 advising on decisions about pricing or design 'made in light of similar or  
27 corresponding information about a competitor.'" *Id.* The court further held that  
28 "proper review of protective orders in cases such as this requires the district court to

1 *examine factually all the risks and safeguards* surrounding inadvertent disclosure  
 2 by any counsel.” *Id.* (emphasis added).

3 Despite claiming that *Brown Bag* “requires that Dr. Dean be a competitive  
 4 decision maker,” Isis cannot disagree that *Brown Bag* requires this analysis of all  
 5 the facts and circumstances, rather than imposing categorical requirements, and  
 6 indeed Isis describes *Brown Bag* as adopting a “balancing approach.” *Jt. Mot.* at  
 7 17. Yet Isis suggests that Santaris has somehow “disavow[ed]” *Brown Bag* by  
 8 applying precisely this approach. *Id.* at 9. In fact, Santaris agrees that, because Dr.  
 9 Dean fails the *Brown Bag* balancing test, Santaris plainly cannot have acted  
 10 unreasonably in refusing to permit disclosure of its most sensitive and confidential  
 11 information to him. However, the Amended Protective Order – which was signed  
 12 twenty years after *Brown Bag* – provides *additional* protections, beyond the  
 13 balancing guaranteed by *Brown Bag*; specifically, it precludes disclosures to  
 14 “independent experts,” which Dr. Dean does not qualify as, and guarantees that  
 15 Santaris may object to *any* expert so long as that objection is not unreasonable.  
 16 *Brown Bag* simply holds that, even without these provisions, the courts must still  
 17 engage in a balancing approach to determine whether a disclosure to a proposed  
 18 person is appropriate.

19 As set forth in the initial joint motion, disclosure to Dr. Dean presents  
 20 precisely the risk of inadvertent disclosure that counsels in favor of serious caution.  
 21 *See In re Deutsche Bank Trust Company Americas*, 605 F.3d 1373, 1378 (Fed. Cir.  
 22 2010) (“It is very difficult for the human mind to compartmentalize and selectively  
 23 suppress information once learned, no matter how well-intentioned the effort may  
 24 be to do so.”). [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED]  
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1 [REDACTED]  
2 [REDACTED]  
3 In *Symantec Corp. v. Acronis Corp.*, 2012 U.S. Dist. LEXIS 117350 (N.D.  
4 Cal. Aug. 20, 2012), the Northern District of California respected a litigant's  
5 objections to the disclosure of its confidential information under a protective order  
6 to a consultant who "actively consults" in the area at issue in the litigation. *Id.* at  
7 \*8. Isis attempts to distinguish *Symantec* or urges this Court to ignore it. *Jt. Mot.*  
8 at 17-18. But Isis does not dispute the truth of the statement that *Symantec* makes  
9 that is most relevant here: "Neither the parties nor the Court on its own have been  
10 able to identify a case within the Ninth Circuit where a party's objections to an  
11 expert were overruled where that expert actively consulted in the very field at  
12 issue." *Symantec*, 2012 U.S. Dist. LEXIS 117350, at \*10 n.1. Although Isis  
13 exaggerates the extent to which Dr. Dean has "uncommon knowledge" (*see infra* at  
14 18), the critical point is that *Symantec* recognizes, and Isis is unable to dispute, that  
15 disregarding a litigant's objection to an expert who, like Dr. Dean, "actively  
16 consult[s] in the very field at issue," is unprecedented.

17 Moreover, as set forth above, Dr. Dean's clients are perceived by Santaris's  
18 counsel as competitors. *See supra* at 23. Given that the Protective Order  
19 recognizes that experts who actively consult with competitors may be ineligible for  
20 disclosure of the most confidential information, Santaris's reasonable perception of  
21 Dr. Dean's clients as competitors should be more than sufficient to give Santaris a  
22 reasonable basis to object. Similarly, Dr. Dean does not represent that he will not  
23 take on additional competitor clients in the future, and in fact, two of his current  
24 competitor clients were recruited by Dr. Dean in 2013, at a time when he was  
25 seeking to gain Santaris's most secret information.

26 Even a narrow focus on whether Dr. Dean actually participates in  
27 competitive decision making likewise confirms the reasonableness of Santaris's  
28 objection. The court in *Brown Bag* specifically explained that the issue is whether

1 “in-house counsel was involved in ‘competitive decision making,’” not whether the  
 2 individual actually made the decisions. *Brown Bag*, 960 F.2d at 1470. That makes  
 3 good sense; the concern is whether in-house counsel is in a position where  
 4 knowledge of the competitor’s information might be inadvertently misused.  
 5 Whether that happens because the party that reviewed the confidential information  
 6 itself makes a competitive decision based on that information, or because the party  
 7 reviewing the confidential information is influenced by it in rendering advice to the  
 8 actual decision maker, is logically irrelevant. In either case, the producing party  
 9 risks prejudice from inadvertent misuse of its confidential information.

10 Isis claims that *Santella v. Grizzly Industries* replaces the “factor” of whether  
 11 the party seeking access is involved in competitive decision making with a  
 12 *requirement* that the party seeking access *be* the decision maker. *Jt. Mot.* at 11.  
 13 But its claim is simply inconsistent with *Santella*, which specifically followed  
 14 *Brown Bag* in noting that “a crucial factor in evaluating the risk of inadvertent  
 15 disclosure is whether the person seeking access *was involved in* competitive  
 16 decision-making; that is, *advising on decisions about pricing or design* made in  
 17 light of similar or corresponding information about a competitor.” *Santella*, 2012  
 18 U.S. Dist. LEXIS at \*12 (quoting *Brown Bag*, 960 F.2d at 1470) (first emphasis  
 19 added; internal quotation marks omitted).<sup>18</sup> The court then concluded that the party  
 20 seeking access in that case was merely “in contact with competitive decision-  
 21 makers,” and that the “type of information at issue . . . [wa]s not amenable to  
 22 inadvertent disclosure” anyway. *Id.* at \*19.

23 Dr. Dean is in a position to provide significant influence directly on the  
 24 competitive decision making of his clients. Companies hire Dr. Dean specifically

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25 <sup>18</sup> Although *Santella* speaks in terms of whether the party seeking access “is a  
 26 ‘competitive decision-maker’” – apparently the way the issue was framed the  
 27 parties – it unambiguously holds that a “competitive decision-maker” is one who  
 28 “advis[es] on decisions about pricing or design made in light of similar or  
 corresponding information about a competitor.” *Santella*, 2012 U.S. Dist. LEXIS at  
 \*14 (alteration in original; internal quotation marks omitted).

1 so that, with respect to scientific matters, he can “advise on business decisions,”  
 2 the very definition of a person who is “involved in ‘competitive decision-making.’”  
 3 *Markey v. Verimatrix, Inc.*, 2009 WL 1971605, at \*3 (S.D. Cal. July 8, 2009). Dr.  
 4 Dean has significant scientific expertise, [REDACTED]

5 [REDACTED]  
 6 [REDACTED]  
 7 [REDACTED]  
 8 [REDACTED]  
 9 [REDACTED] Plainly, companies place him in these roles so that he  
 10 may advise them with respect to their scientific decisions—the precise decisions  
 11 where Santaris’s confidential information would be most relevant.

12 It is worth noting that despite Isis’s continued implications that Santaris is  
 13 suggesting that Dr. Dean “cannot be trusted,” that is neither Santaris’s position nor  
 14 the required standard under the law. *Jt. Mot.* at 10.<sup>19</sup> Nor is the question whether  
 15 there is a sufficient risk of inadvertent disclosure to outweigh Isis’s interest in using  
 16 the expert of its choice. Santaris needs to show only that it is acting reasonably in  
 17 concluding that Dr. Dean *may* inadvertently disclose its confidential information *or*  
 18 that the confidential information will become so intertwined with his other  
 19 knowledge such that it will be disclosed, inadvertently or otherwise, in the course  
 20 of his work. Dr. Dean’s involvement in providing scientific advice for competitive  
 21 companies, and the difficulty of erasing target and sequence information, once  
 22 learned, is sufficient to justify Santaris’s decision.

23 [REDACTED]  
 24 [REDACTED]  
 25  
 26 <sup>19</sup> Isis overstates that Dr. Dean “has acted scrupulously before this Court on the  
 27 confidentiality he owes to all his clients,” given that he has represented to the Court  
 28 that his very retentions are confidential, when in fact some of them have been  
 publicly disclosed. *See Johnson Decl. Exh. B.*



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[REDACTED]

**2. Santaris Has Reasonable Concern about Dr. Dean's Close and Longstanding Relationship with Isis**

Dr. Dean's relationship with Isis is of such long tenure, and so substantial, that Santaris cannot have acted unreasonably in objecting to disclosure because of

1 it. Isis attempts to combine this inquiry with that of independence, and suggests a  
 2 variety of tests “to assess whether an expert is independent from the party.” Of  
 3 course, with respect to whether Dr. Dean is an “Independent Expert,” the inquiry is  
 4 set forth in the Amended Protective Order, and the tests that apply when the  
 5 protective order *lacks* a definition are irrelevant. *See, e.g., Beam Sys., Inc. v.*  
 6 *Checkpoint Sys., Inc.*, 1997 WL 364081, at \*4 (C.D. Cal. Feb. 6, 1997)) (reducing  
 7 the inquiry into “independence” into whether the party seeking access was  
 8 independent of a party).<sup>20</sup>

9 Santaris’s argument about Dr. Dean’s close relationship with Isis extends  
 10 beyond the concept of “independence” as that concept is used in the case law,  
 11 although it is related to it. Dr. Dean worked at Isis for 15 years, is the co-inventor  
 12 on 43 antisense patents assigned to Isis between 1997 and 2012, and even after  
 13 leaving Isis worked very closely with Isis through Excaliard, which had an  
 14 extensive and lucrative collaboration with Isis. But for Isis’s support over the years  
 15 with technology and investment in Excaliard, Dr. Dean would likely not have made  
 16 the many millions he was paid on the sale of Excaliard in 2012 to Pfizer. It is  
 17 worth noting that Isis too was enriched by many millions in that sale, and both Isis  
 18 and Dr. Dean likely will be paid yet more by Pfizer in earn out or related  
 19 compensation if their drug is successful. Although Isis previously said that there  
 20 was “no evidence of ongoing social relationships with people at Isis,” it now  
 21 acknowledges that Dr. Dean does have such a social relationship with Dr. Frank  
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23 <sup>20</sup> Isis claims that Santaris has a “shifting view” of precedent because it both argues  
 24 that *Beam* supports it and acknowledges that *Beam* contained a protective order  
 25 with a narrower conception of independence than the parties’ current protective  
 26 order. *Jt. Mot.* at 9 n.4. But Isis misunderstands Santaris’s argument. *Beam*  
 27 supports Santaris’s view that Dr. Dean is not independent of Isis because of his  
 28 “close, profitable, and longstanding business relationship” with Isis. *Beam Sys.,*  
*Inc. v. Checkpoint Sys., Inc.*, 1997 WL 364081, at \*5 (C.D. Cal. Feb. 6, 1997).  
*Beam* also demonstrates that case law regarding “independence” cannot be applied  
 to this case without being cognizant of the fact that the Amended Protective Order  
 specifically defines the term “independent expert” more broadly than many of the  
 cases by focusing on the parties’ competitors, not just the parties themselves.

1 Bennett, Isis's Senior Vice President of Research responsible antisense drug  
2 discovery and antisense technology research. Johnson Decl. Exh. C.

3 After he left Isis, Dr. Dean continued to collaborate with Isis and its  
4 personnel in filing new patent applications on antisense technology. Dr. Dean did  
5 so while he was at Excaliard, notwithstanding the fact that Isis now claims there  
6 was no relationship between Isis and Excaliard or Isis and Dr. Dean. Not true.  
7 Several of the patent applications that Dr. Dean filed after he left Isis were assigned  
8 jointly to Isis and Excaliard. *See* Johnson Decl. Exhs. S & T. And two others were  
9 not assigned at all, they are jointly held by Dr. Dean and several Isis employees,  
10 including Dr. Bennett. *Id.* at Exhs. E & F. Dr. Dean's continued relationship and  
11 collaboration work with Isis's top management highlights why Santaris's objection  
12 is reasonable. Moreover, it sharply distinguishes Dr. Dean from [REDACTED]  
13 [REDACTED]

### 14 **3. There Is No Substantial Prejudice To Isis**

15 Although Isis claims that it will be prejudiced from not being able to disclose  
16 Santaris's most sensitive confidential information to Dr. Dean, that prejudice is  
17 unsubstantiated and, to the extent it exists, is a product of Isis's own decisions or  
18 those of Dr. Dean.

19 *First*, Isis's position that it could not find another expert continues to be  
20 unsupported. Santaris has consistently noted that standard expert databases contain  
21 a significant number of experts in the fields of antisense and oligonucleotide  
22 technology. Johnson Decl. Exh. U. And there are other organizations such as IBC  
23 Life Sciences and GTCbio through which experts in antisense can be found. *See*,  
24 *e.g.*, Johnson Decl. Exhs. V-Y. Isis has never offered the name of any other expert  
25 it considered, or any information, even at a general level, regarding its purportedly  
26 futile search. Nor has Isis ever proposed to Santaris an alternative to Dr. Dean, so  
27 Isis's imagination about what Santaris might do if and when Isis proposes a  
28 substitute for Dr. Dean are untested and unsupported speculation.

1        *Second*, Santaris has allowed Isis's other two experts—Drs. Gordon and  
 2        Gelfman—to view Santaris's highly confidential information. To the extent that  
 3        Isis truly needs yet a third expert to see that same information, Santaris is open to  
 4        considering a nominee on the particular facts presented by her.

5        *Third*, to the extent that Isis has invested time in Dr. Dean, that too is Isis's  
 6        own choice. Santaris objected to the disclosure of confidential information to Dr.  
 7        Dean over 6 months ago, on November 6, 2012. To the extent that Isis has  
 8        continued to invest in Dr. Dean, it has done so with the knowledge that Santaris has  
 9        serious concerns about disclosure of Santaris materials to him. That strategic  
 10       decision should not now assist Isis in arguing that Santaris's objection to Dr. Dean  
 11       is unreasonable.

12       *Fourth*, [REDACTED]  
 13       [REDACTED]  
 14       [REDACTED]  
 15       [REDACTED]  
 16       [REDACTED]  
 17       [REDACTED]

18       *Fifth*, Santaris's objection is limited to the disclosure of confidential Santaris  
 19       materials to Dr. Dean. Santaris is not blocking Isis's use of Dr. Dean as an expert.  
 20       Again, Isis's decision not to use him in that capacity to review non-confidential  
 21       documents or Isis's own documents is one of its own making.

22       **C. SANTARIS WOULD BE PREJUDICED BY PERMITTING ISIS'S PROPOSED**  
 23       **DISCLOSURE TO DR. DEAN**

24       Finally, Santaris would experience substantial prejudice if Isis were  
 25       permitted to disclose its confidential information to Dr. Dean. Santaris produced  
 26       millions of pages of highly competitive, confidential material under the Protective  
 27       Order with the understanding that the documents would be shielded from those  
 28       individuals who were not independent from Isis and as to whom Santaris could

1 object so long as it was reasonable. The rules should not be changed at this point in  
2 the litigation.

3 Inadvertent disclosure of Santaris's most confidential information would  
4 inflict serious harm on Santaris. Santaris's choices of which of the thousands of  
5 potential specific RNA molecules to target are among its most closely guarded  
6 trade and scientific secrets. Bojko Decl. ¶ 8. Santaris's Senior Director of  
7 Intellectual Property, Maja Bojko, explains that "disclosing merely the identity of  
8 the targets—even without disclosing any other technical details—conveys valuable  
9 and competitive information about Santaris's commercial and therapeutic strategy."  
10 *Id.* When competitors become aware of the results of Santaris's experiments, those  
11 competitors learn both of promising targets and unpromising paths not worth  
12 pursuing. *Id.* Given that Dr. Dean has "ongoing relationships with competitors in  
13 the field," there is a "tangible risk" that he "will not be able to separate the highly  
14 confidential information he gleans from reviewing" Santaris's documents, such as  
15 this target information, from "his consulting and publication work" in the same  
16 field. *Symantec Corp.*, 2012 WL 3582974, at \*3. Even beyond the disclosure of  
17 target information or where the targets are publicly known, the specific "potential  
18 binding sites on any individual target RNA molecule for which one may design an  
19 antisense oligonucleotide to bind, or the methods and assays used to design an  
20 optimal antisense oligonucleotide is also competitively valuable information." *Id.*  
21 Given that Dr. Dean has "ongoing relationships with competitors in the field," there  
22 is a "tangible risk" that he "will not be able to separate the highly confidential  
23 information he gleans from reviewing" Santaris's documents, from "his consulting  
24 and publication work" in the same field. *Symantec Corp.*, 2012 WL 3582974, at  
25 \*3.

26 [REDACTED]  
27 [REDACTED]  
28 [REDACTED] While Santaris respects Isis's right, under the Amended

Protective Order, to object to such disclosures so long as it was not unreasonable, Santaris's motion for summary judgment is due in a matter of weeks and Santaris has been foreclosed from sharing "outside counsel only" information [REDACTED]. That is what the Amended Protective Order provides and that is what right Isis has exercised – the same right that Santaris has exercised with regard to Dr. Dean. And even if Isis were to withdraw or was required to withdraw its objection to [REDACTED] if Dr. Dean is permitted to view Santaris's confidential information, Isis's objection to [REDACTED] has ensured that Santaris has insufficient time to have [REDACTED] review Isis's documents in time to include his views on that information in the summary judgment motion to be filed on June 24.

Respectfully submitted,

**MCDERMOTT WILL & EMERY LLP**

DATED: June 10, 2013

By: /s/ William G. Gaede, III  
William G. Gaede, III

*Attorneys for Isis Pharmaceuticals, Inc.*

**GIBSON, DUNN & CRUTCHER LLP**

DATED: June 10, 2013

By: /s/ Frederick Brown

*Attorneys for Santaris Pharma A/S Corp.  
and Santaris Pharma A/S*

### SIGNATURE ATTESTATION

I hereby attest that concurrence has been obtained from Ashley Johnson – on behalf of Frederick Brown, counsel for Santaris Pharma A/S and Santaris Pharma A/S Corp, as indicated by a "conformed" signature (/s/) within this e-filed document.

/s/ William G. Gaede, III

William G. Gaede, III